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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,178	07/19/2000	Donald J. Boulia	RSW9-2000-0054-US1	1042
43168	7590	03/27/2008	EXAMINER	
MARCIA L. DOUBET LAW FIRM PO BOX 422859 KISSIMMEE, FL 34742				DUONG, OANH L
ART UNIT		PAPER NUMBER		
		2155		
			NOTIFICATION DATE	DELIVERY MODE
			03/27/2008	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD J. BOULIA

Appeal 2007-2305
Application 09/619,178¹
Technology Center 2100

Decided: March 25, 2008

Before ANITA PELLMAN GROSS, ALLEN R. MACDONALD, and
MARC S. HOFF, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a Final Rejection of claims 1-31. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellant's invention relates to method, system, and computer program product for sending Transmission Control Protocol (TCP) messages

¹ Application filed July 19, 2000. The real party in interest is International Business Machines Corporation.

through a network using the HyperText Transfer Protocol (HTTP) and HTTP-based systems (Specification 1).

Claim 1 is exemplary:

1. A computer program product for sending Transmission Control Protocol (TCP) messages through HyperText Transfer Protocol (HTTP) systems, the computer program product embodied on one or more computer-readable media and comprising:

computer-readable program code means for establishing a send channel from a first component on a client side of a network, through one or more HTTP-based systems, to a second component on a remote side of the network;

computer-readable program code means for establishing a receive channel from the first component, through the one or more HTTP-based systems, to the second component, wherein the receive channel is distinct from the send channel;

computer-readable program code means for establishing a first TCP connection from a client on the client side to the first component;

computer-readable program code means for establishing a second TCP connection from the second component to a target server on the remote side;

computer-readable code means for transmitting client-initiated TCP requests from the client to the target server by packaging the client-initiated TCP requests into HTTP messages which are transmitted on the send channel; and

computer-readable program code means for transmitting server-initiated TCP requests from the target server to the client by packaging the server-initiated TCP requests into HTTP messages which are transmitted on the receive channel.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Erickson US 6,412,009 B1 Jun. 25, 2002

Inala US 6,442,590 B1 Aug. 27, 2002

Fielding, R. et al. (Fielding) "Hyper Text Transfer Protocol Specification 1.1" RFC 2068 (1997), <http://ftp.ics.uci.edu/pub/ietf/http/rfc2068.txt>.

Claims 1-4, 8, 10-13, 17, 19-22, 26, 28, 29, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Erickson in view of Inala.

Claims 5, 9, 14, 18, 23, 27, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Erickson in view of Inala and Fielding.²

Appellant contends that the Examiner erred in his rejections because, in Appellant's view, Erickson teaches away from the claimed invention by establishing a single connection for all data transmissions (Br. 13). The Examiner contends the claims are properly rejected because Inala teaches a receive channel distinct from a send channel, and in the Examiner's opinion modifying Erickson in view of Inala would have resulted in a simpler and more cost-effective system (Ans. 5).

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The principal issue in the appeal before us is whether Erickson teaches away from Appellant's claimed invention including distinct send and receive channels such that the person having ordinary skill in the art

² The rejection of claims 6, 7, 15, 16, 24, and 25 was withdrawn in the Examiner's Answer at pages 21-22.

would not have been motivated to combine Erickson and Inala to arrive at the instant invention.

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

The Invention

1. According to Appellant, he has invented a method, system, and computer program product for sending Transmission Control Protocol (TCP) messages through a network using the HyperText Transfer Protocol (HTTP) and HTTP-based systems (Specification 1).

2. A send channel is established from a first component on a client side of a network connection, through one or more HTTP-based systems, to a second component on a remote side of a network connection (Specification 5). Client-initiated TCP requests are transmitted on the send channel (id.).

3. A receive channel, distinct from the send channel, is established from the first component, through the one or more HTTP-based systems, to the second component (Specification 5). Server-initiated TCP requests are transmitted on the receive channel (id.).

Erickson

4. Erickson teaches supporting a legacy communications protocol (Telnet) by providing a persistent HTTP tunnel for a persistent virtual session (col. 2, ll. 41-43).

5. Erickson teaches that because only one connection is needed during the communication flow, the present invention provides performance

comparable to workstations connected through a LAN to a host system (shown in Fig. 1) and responses that are less variable than response times of prior art methods using translated HTML statements (col. 7, ll. 57-61).

Inala

6. Inala teaches a method and apparatus that enables real-time chat capability that is URL-sensitive in real time such that individuals visiting a URL may be detected and offered an opportunity to engage in chat with other individuals visiting the same URL (col. 3, ll. 49-53).

7. In a preferred embodiment two HTTP connections are opened to server 17. One connection is for sending data and one is for receiving data (col. 8, ll. 30-32).

Fielding

8. Fielding teaches Internet standards for the HTTP/1.1 protocol (Abstract).

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*citing In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. *Piasecki*, 745 F.2d at 1472. Thus, the Examiner must not only assure that the requisite

findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the Examiner's conclusion.

The determination of obviousness must consider, *inter alia*, whether a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and whether there would have been a reasonable expectation of success in doing so. *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1124 (Fed. Cir. 2000). *Medichem S.A. v. Rolabo S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006). Where the teachings of two or more prior art references conflict, the Examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Further, our reviewing court has held that “[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994); *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085, 1090 (Fed. Cir. 1995).

ANALYSIS

Appellant argues, *inter alia*, that the Examiner erred in rejecting independent claims 1, 10, 19, 28, and 31 as being obvious over Erickson in view of Inala, because Erickson teaches away from Appellant's limitations of distinct send and receive channels for the transmission of TCP requests. Appellant alleges that Erickson's disclosure describes the use of a single connection for transmitting messages between a Web client and Web server (col. 3, ll. 4-23), which Erickson characterizes as advantageous (FF 5). As a result, Appellant concludes, the person having ordinary skill in the art would not have been motivated to introduce multiple connections into Erickson's disclosed teachings (Br. 14).

The Examiner, in continuing to reject the claims as obvious over Erickson in view of Inala, admits that Erickson "does not explicitly teach the receive channel is distinct from the send channel" (Ans. 5), but argues that it would have been obvious to modify Erickson to include the distinct send and receive connections of Inala in order to "improve the efficiency of transmission in term of cost (i.e., less hardware and cost associated therewith may be required to support one-way communication, as contrasted with two-way communication) and simplicity (i.e., one-way communication is often easier to establish than two-way communication) required for the connections" (Ans. 5). The Examiner argues that the common classification of Erickson and Inala within the USPTO is further evidence in favor of making the combination (Ans. 19).

We disagree with the Examiner. Erickson teaches that "[b]ecause *only one connection* is needed during the communication flow, the present

invention provides performance comparable to workstations connected through a LAN to a host system (shown in Fig. 1) and responses that are less variable than response times of prior art methods using translated HTML statements” (FF 5, emphasis added).

The Examiner presents no rebuttal to Appellant’s position that Erickson teaches away from establishing two distinct communication channels, stating only that Inala is relied upon to teach two channels and that Appellant may not show nonobviousness by attacking the references individually (Ans. 17-18).

With respect to the Examiner’s statement regarding the motivation to modify Erickson to include two distinct channels as suggested by Inala, it is at best questionable that establishing two channels rather than one would be more cost-efficient; it seems more likely that, as Appellant argues, such a configuration would be *more* expensive, rather than less (Reply Br. 4). The greater simplicity of one-way communication alleged by the Examiner (Ans. 5) is similarly speculative and unsupported. Finally, we find the common USPTO classification of Erickson and Inala insufficiently persuasive to overcome Erickson’s explicit teaching of one connection rather than two.

Because of the advantages of a single connection expressed in Erickson, we find that a person of ordinary skill in the art would have been led in the direction of establishing a single connection, which is divergent from the two-connection path taken by Appellant. *See In re Gurley, supra.* Because the Examiner has made no direct rebuttal to Appellant’s argument that Erickson teaches away from the claimed invention, and because we find the Examiner’s statement of reasons to combine Erickson with Inala to be

unpersuasive, we conclude that the person having ordinary skill in the art would not have been motivated to combine the Erickson and Inala references in the manner proposed by the Examiner. With respect to claims 5, 9, 14, 18, 23, 27, and 30, we have reviewed Fielding, and find that it does not supply the motivation to modify Erickson which we consider to be lacking from Inala. We conclude that the Examiner erred in rejecting the claims under 35 U.S.C. § 103.

We therefore reverse the rejection of claims 1, 10, 19, 28, and 31, as well as claims 2-5, 8, 9, 11-14, 17, 18, 20-23, 26, 27, 29, and 30 dependent therefrom.

CONCLUSION OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1-5, 8-14, 17-23, and 26-31. On the record before us, claims 1-5, 8-14, 17-23, and 26-31 have not been shown to be unpatentable.

DECISION

The Examiner's rejection of claims 1-5, 8-14, 17-23, and 26-31 is reversed.

Appeal 2007-2305
Application 09/619,178

REVERSED

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